

January 4, 2002

MEMORANDUM

TO: GARY V. HARKCOM
Vice Chief Administrative Patent Judge

All Administrative Patent Judges

FROM: BRUCE H. STONER, JR.
Chief Administrative Patent Judge

SUBJECTS: Standard Operating Procedure 1 (Revision 10)
Assignment of judges to merits panels, motions panels, and expanded panels

The attached document supersedes Standard Operating Procedure 1 (Revision 9) dated June 29, 2001, on the same subject matter. The principal changes in this revision are those reflecting the departure of Judges Calvert (November 3, 2001) and Robinson (January 12, 2002) and the arrival of Judges Moore (November 5, 2001), Poteate (November 5, 2001), Nagumo (November 14, 2001), Saadat (November 14, 2001) and Green (December 3, 2001). The effective date of this Standard Operating Procedure is January 14, 2002.

cc: Amalia Santiago, Chief Board Administrator

All Program and Resources Administrators

BOARD OF PATENT APPEALS AND INTERFERENCES

STANDARD OPERATING PROCEDURE 1 (REVISION 10)

Effective January 14, 2002

ASSIGNMENT OF JUDGES TO MERITS PANELS, MOTIONS PANELS, AND EXPANDED PANELS

The following applies to the assignment of judges to merits panels,¹ motions panels,² and expanded panels³ in *ex parte* appeals and interferences.⁴

Except as provided in section V.C. of this Standard Operating Procedure, assignments (designations under 35 U.S.C. § 6) of Administrative Patent Judges to panels of the Board of Patent Appeals and Interferences are made by the Chief Board Administrator, assisted by the Program and Resources Administrators, under the direction of the Chief Judge. The Director's authority under 35 U.S.C. § 6 to designate panels has been delegated to the Chief Judge. *See Manual of Patent Examining Procedure* § 1002.02(f) (8th ed., Aug. 2001).

This Standard Operating Procedure creates internal norms for the administration of the Board of Patent Appeals and Interferences. It does not create any legally enforceable rights.

I. Administrative Divisions of the Board

A. Chief Judge Stoner and Vice Chief Judge Harkcom are *ex officio* members of all administrative divisions and may administer interferences or otherwise participate in rendering panel decisions.

B. The **Interference Division** (in order of seniority; members of the **Trial Section** within this division are designated by an asterisk):

1. Urynowicz
2. Caroff
3. Metz
4. Pate
5. Martin

¹ Three-judge panels designated to decide *ex parte* appeals and enter final decisions in interferences.

² Three-judge panels designated to enter interlocutory orders where a panel is appropriate, including, e.g., requests for reconsideration of non-final decisions in interferences.

³ Panels consisting of more than three judges.

⁴ A merits or motions panel may include all judges (including any senior judge) assigned to the Trial Section of the Interference Division when an interference assigned to the Trial Section involves a significant procedural issue applicable to proceedings before the Trial Section and the Trial Section judges deem it appropriate to issue an opinion binding on the Trial Section.

6. McKelvey*
7. Schafer*
8. Gron
9. Lee*
10. Hanlon
11. Ellis
12. Crawford
13. Torczon*
14. Lorin
15. Spiegel*
16. Gardner-Lane*
17. Medley*
18. Tierney*

C. The **Biotechnology Division** (in order of seniority):

1. Winters
2. William F. Smith
3. Scheiner
4. Adams
5. Mills
6. Grimes
7. Green

D. The **Chemical Division** (in order of seniority):

1. Kimlin
2. Garris
3. Pak
4. Warren
5. Owens
6. Waltz
7. Lieberman
8. Kratz
9. Timm
10. Delmendo
11. Jeffrey T. Smith
12. Pawlikowski
13. Moore
14. Poteate
15. Nagumo

E. The **Electrical Division** (in order of seniority):

1. Thomas
2. Hairston

3. Krass
4. Jerry Smith
5. Barrett
6. Fleming
7. Ruggiero
8. Lall
9. Dixon
10. Gross
11. Barry
12. Levy
13. Blankenship
14. Saadat

F. The **Mechanical Division** (in order of seniority):

1. McCandlish
2. Cohen
3. Abrams
4. Frankfort
5. Staab
6. McQuade
7. Nase
8. Bahr

II. Divisional responsibilities for *ex parte* appeals

A. In general, one judge from either the Chemical Division or the Biotechnology Division, and one judge from each of the Electrical Division and the Mechanical Division will be designated as the merits panel to decide *ex parte* design and plant appeals.

B. In general, a merits panel to decide *ex parte* appeals originating in Technology Center 1600 will be selected from judges assigned to the Biotechnology Division.⁵

C. In general, a merits panel to decide *ex parte* appeals originating in Technology Center 1700 will be selected from judges assigned to the Chemical Division.

D. In general, a merits panel to decide *ex parte* appeals originating in Technology Centers 2100, 2600 and 2800 will be selected from judges assigned to the Electrical Division.

E. In general, a merits panel to decide *ex parte* appeals originating in Technology Centers 3600 and 3700 will be selected from judges assigned to the Mechanical Division.

⁵ *Ex parte* appeals involving organic chemistry of a non-pharmaceutical nature will generally be assigned to a merits panel of judges selected from the Chemical Division.

F. Judges assigned to the Interference Division may be assigned to merits panels deciding *ex parte* appeals from time-to-time as follows:

1. Judges McKelvey, Gron, Ellis, Torczon, Lorin, Spiegel and Gardner-Lane may be designated to merits panels deciding *ex parte* appeals assigned to the Biotechnology Division.
2. Judges Caroff, Metz, McKelvey, Schafer, Hanlon and Tierney may be designated to merits panels deciding *ex parte* appeals assigned to the Chemical Division.
3. Judges Urynowicz, Martin, Lee, Torczon and Medley may be designated to merits panels deciding *ex parte* appeals assigned to the Electrical Division.
4. Judges Pate and Crawford may be designated to merits panels deciding *ex parte* appeals assigned to the Mechanical Division.

G. Concerning panel assignments of *ex parte* appeals involving judges of the Interference Division, the following will generally apply:

1. Judges assigned to the Interference Division generally will not be assigned as the second or third judge on any *ex parte* appeal.
2. Judges assigned to the Interference Division generally will not be assigned to *ex parte* oral hearings.

III. Inter-Divisional Panels in Appropriate Cases

Where appropriate (based on the technology and/or legal issue involved), one judge from the Chemical Division or the Biotechnology Division, one judge from the Electrical Division, and one judge from the Mechanical Division may be designated as the merits panel to decide an *ex parte* appeal.

Where appropriate (based on the technology and/or legal issue involved), one or more judges from any of the Biotechnology, Chemical, Electrical or Mechanical Divisions may be designated as members of an interference panel.

IV. Expanded Panels

From time to time it may be necessary to expand a merits or motions panel. The following applies to the use of expanded panels.

A. Reasons for expanding a panel include:

1. An issue of exceptional importance.
2. Conflicting decisions by different panels of the Board.

3. A substantial difference of opinion among judges on an issue pending before the Board.
 4. When a panel determines that it cannot follow a previously published precedential decision of the Board
- B. Generally eleven judges will be designated to decide cases in which an expanded panel is to be used. The Chief Judge will determine when an expanded panel is to be designated.
- C. A judge, a merits panel, or a motions panel may suggest to the Chief Judge the need for the designation of an expanded panel. Likewise, the Patent Examining Operation,⁶ an applicant or patent owner in an *ex parte* appeal, or a party in an interference may suggest the need for an expanded panel.
- D. When an expanded panel is designated (1) after a case initially has been assigned to a three-judge panel and (2) before a decision is entered by the merits panel, the judges initially designated shall be designated as part of the expanded panel.
- E. When an expanded panel is designated (1) after entry of a decision by a merits panel and (2) to consider a request for reconsideration of the decision of the merits panel, the judges on the merits panel shall be designated as part of the expanded panel. The expanded panel shall decide the reconsideration on its merits.
- F. Expanded panels shall consist of the Chief Judge and ten additional judges to be assigned by the Chief Board Administrator under the general direction of the Chief Judge. The selection of the ten additional judges shall be based on the type of case from the "Group Listings" set out below. As indicated in Standard Operating Procedure No. 8 (October 20, 1995), a Senior Judge is not eligible to participate in expanded panel decisions unless that judge was a member of an original three-member panel that was subsequently expanded prior to decision or on reconsideration.
- G. When the Chief Judge is disqualified, recused, or otherwise unable to sit, the Vice Chief Judge shall be designated to serve on the expanded panel and shall preside.
- H. When the Chief Judge and the Vice Chief Judge are disqualified, recused, or otherwise unable to sit, an eleventh judge shall be assigned by the Chief Board Administrator and the most senior judge shall preside.

⁶ There may be times when the Patent Examining Operation determines that it would not be in the public interest to follow a prior published precedential decision of the Board. Under those circumstances, the Patent Examining Operation should be free to ask the Board to reconsider and overrule a prior decision. In doing so, the Patent Examining Operation should identify the prior decision, indicate that it is not being followed, and if an appeal is taken to the Board the Patent Examining Operation may ask the Chief Judge to designate an expanded panel to consider whether to overrule the prior decision.

I. The assignment by the Chief Board Administrator shall take place after the Chief Judge determines that an expanded panel shall be designated. The assignments shall be such that, on average, all judges within a group listing participate an equal number of times on expanded panels. A written record of assignments to expanded panels shall be maintained by the Chief Board Administrator and shall be available to any judge upon request.

J. In an appropriate circumstance, the Chief Judge may designate an expanded panel consisting of more than eleven judges, including an expanded panel consisting of all judges, to decide a case.

K. "Group Listings" from which expanded panels are to be selected to the extent possible are as follows:

1. Interference cases with a significant interference issue (as opposed to a significant patentability issue):

- a) Chief Judge
- b) Seven judges from the group consisting of the Vice Chief Judge and the judges assigned to the Interference Division
- c) One judge from the Chemical Division or the Biotechnology Division
- d) One judge from the Electrical Division
- e) One judge from the Mechanical Division.

2. An *ex parte* appeal with a significant issue of general applicability within all Divisions, a significant design or plant issue:

- a) Chief Judge
- b) Three judges from the Chemical Division or the Biotechnology Division
- c) Three judges from the group consisting of the Vice Chief Judge and the judges assigned to the Electrical Division
- d) Three judges from the Mechanical Division
- e) One judge from the Interference Division.

3. An *ex parte* appeal with a significant issue of general applicability within essentially only the Biotechnology Division:

- a) Chief Judge
- b) Seven judges from the group consisting of the Vice Chief Judge and the following judges assigned to the Biotechnology Division or the Interference Division, including:
 - (1) Winters
 - (2) William F. Smith
 - (3) Gron

- (4) Ellis
 - (5) Torczon
 - (6) Lorin
 - (7) Spiegel
 - (8) Scheiner
 - (9) Adams
 - (10) Mills
 - (11) Gardner-Lane
 - (12) Grimes
 - (13) Green
 - c) One judge from the Chemical Division
 - d) One judge from the Electrical Division
 - e) One judge from the Mechanical Division
4. An *ex parte* appeal with a significant issue of general applicability within essentially only the Chemical Division:
- a) Chief Judge
 - b) Seven judges from the group consisting of the Vice Chief Judge and the following judges assigned to the Chemical Division or the Interference Division, including:
 - (1) Caroff
 - (2) Metz
 - (3) Kimlin
 - (4) Garris
 - (5) Schafer
 - (6) Hanlon
 - (7) Pak
 - (8) Warren
 - (9) Owens
 - (10) Waltz
 - (11) Lieberman
 - (12) Kratz
 - (13) Timm
 - (14) Delmendo
 - (15) Jeffrey T. Smith
 - (16) Tierney
 - (17) Pawlikowski
 - (18) Moore
 - (19) Poteate
 - (20) Nagumo
 - c) One judge from the Biotechnology Division
 - d) One judge from the Electrical Division
 - e) One judge from the Mechanical Division

5. An *ex parte* appeal with an issue of general applicability essentially only within the Electrical Division:

- a) Chief Judge
- b) Seven judges from the group consisting of the Vice Chief Judge and the judges assigned to the Electrical Division
- c) One judge from the Chemical Division or the Biotechnology Division
- d) One judge from the Mechanical Division
- e) One judge from the Interference Division.

6. An *ex parte* appeal with an issue of general applicability essentially only within the Mechanical Division:

- a) Chief Judge
- b) Seven judges from the group consisting of the Vice Chief Judge and the judges assigned to the Mechanical Division
- c) One judge from the Chemical Division or the Biotechnology Division
- d) One judge from the Electrical Division
- e) One judge from the Interference Division.

7. An expanded panel in an interference with a significant patentability issue will be designated in accordance with the guidelines for *ex parte* cases, except that an interference merits panel will be assigned and all judges on the interference merits panel will be designated on the expanded panel. After a decision is entered by the expanded panel on the patentability issue, the interference may, if appropriate, be remanded to the interference three-judge merits panel to handle any other issues in the interference and for entry of a judgment consistent with the decision of the expanded panel on the patentability issue.

L. All decisions by an expanded panel of 11 or more judges will be circulated to each judge of the Board *prior* to entry of the decision. Within two weeks, each judge *not* designated on the panel may comment on the decision. Comments shall be in writing (for purposes of this Standard Operating Procedure, comments in writing include comments transmitted by e-mail) and shall be presented to the author of the majority opinion, with a copy to the Chief Judge. If a judge does not submit comments, it will be presumed that the judge disagrees with the decision or the opinion in support of the decision. Should it appear that a majority of the judges do not concur with the decision or the opinion, an augmented expanded panel will be designated to cause a decision to be entered which is consistent with the majority view of the judges. Any decision entered by an expanded or an augmented expanded panel will become precedential upon its being published or otherwise disseminated pursuant to Standard Operating Procedure 2, Revision 4.

M. The Chief Judge, the Vice Chief Judge and all Administrative Patent Judges are bound by a published precedential decision of an expanded panel⁷ unless the decision (1) is modified by the Court of Appeals for the Federal Circuit, (2) is shown to be inconsistent with a decision of the Supreme Court or the Court of Appeals for the Federal Circuit, (3) is overruled by a subsequent expanded panel, or (4) is overturned by statute.

V. Assignment of Cases to Judges

A. An order designating a panel (designation order) may be placed temporarily in the file of the application on appeal or the file of the interference. At the conclusion of the case, the designation order may be removed from the file. On those occasions when an order redesignating a panel is necessary, it too may be placed temporarily in the file.

B. A judge initially assigned to handle an interference should arrange for a substitute judge to act on cases in the absence (i.e., leave, etc.) of the judge initially assigned to the interference.

C. Except where a party requests and agrees to entry of a *pro forma* adverse judgment under 37 C.F.R. § 1.662(a), whenever a decision in an interference proceeding requires entry by a panel of judges, the judge to whom the interference is assigned shall request the Chief Board Administrator to assign a panel. In the instance of an interference proceeding assigned to one of the members of the Trial Section, no request to the Chief Board Administrator is ordinarily required.

D. The judges designated on a merits panel, motions panel, or expanded panel shall not be changed without authority of the Chief Judge or the Vice Chief Judge. When satisfied that there is good reason to alter the panel already designated, the Chief Judge or Vice Chief Judge will initial and date the designation order after making whatever changes are determined to be appropriate or will direct the Chief Board Administrator to enter a new designation order. From time to time, the Chief Judge may authorize other employees of the Board to alter the panel already designated and to initial and date changes to the designation order.

E. A reasonable effort should be made to preserve the roles of judges assigned as the Number 1, Number 2, and Number 3 judges in *ex parte* appeals. However, when the judge assigned the role of Number 1 is of the opinion that it would be in the interest of efficient administration of the Board, the judge assigned the role of Number 1 is authorized to change the roles of judges assigned the roles of Number 2 and Number 3. An instance in which it would be appropriate to change the roles is when the judge assigned the role of Number 2 is on leave for more than a brief period of time. If, after conference with the other judges assigned to the appeal, the judge initially assigned the

⁷ Publication of Opinions and Binding Precedent are the subjects of SOP 2 (Revision 4) issued March 29, 2000.

role of Number 1 is not part of the majority, one of the judges initially assigned the roles of Number 2 and Number 3 will author the majority opinion. Any member of a panel may request that the conference include all members of the panel.